

dimethylchroman-6-yl)ethynyl]nicotinic" and insert
--6-(2-(4,4-dimethylchroman-6-yl)ethynyl)nicotinic--.

Claim 17, line 1 continuing into line 2, delete "6-[2-(4,4-dimethylchroman-6-yl)ethynyl]nicotinate" and insert
--6-(2-(4,4-dimethylchroman-6-yl)ethynyl)nicotinate--.

REMARKS

All outstanding claims were rejected in the last Office Action on the basis of 35 U. S. C. Section 112.

More specifically, Claims 1 - 9, 12 - 19 and 26 - 28 were rejected on the basis that the subject matter of these claims (as far as an R_2 group is concerned) is not supported by the specification.

Claims 4, 5, 16 and 17 were rejected on the basis that these claims were indefinite.

The applicant, acting through the undersigned attorney has now amended some of the rejected claims. The following discussion demonstrates why all of the outstanding claims are allowable and why the rejection should not be maintained with respect to any of the outstanding claims.

Rejection of Claims for Indefiniteness

Claims 4, 5, 16 and 17 were rejected on this basis for the sole reason that square brackets used in the chemical names of the claimed compounds is confusing as the use of such square brackets can be confused with the Patent Office's practice of using square brackets to delete objectionable subject matter.

In order to obviate this rejection, each of these four claims were amended in the manner suggested by the Examiner, i. e. the square brackets in the chemical names in these four claims were replaced by circular brackets. Applicant comments that absolutely no change in the substantive content of these claims was intended by the present amendment. Furthermore, inasmuch as each of these four claims is an independent claim and is presently in full compliance with the Examiner's requirements, each of these claims is in prima facie allowable condition.

Rejection of Claims for Lack of Enabling Disclosure

Claims 1 - 9, 12 - 19 and 26 - 28 were rejected on the basis that the substituent (R_2) in the 4-position of the chroman or thiochroman nucleus cannot be defined as "lower alkyl", because this definition is not supported by the specification.

The applicant respectfully submits that with respect to certain claims, the rejection on this ground must have been made in inadvertent error, because these claims do not define the substituent in the 4-position as "lower alkyl" (there is no R_2 substituent).

Specifically, Claim 4 is an independent claim defining a chemical compound by chemical name. There is no R_2 in this claim. The same is true for Claim 5, Claim 16 and Claim 17.

Claim 6 is an independent claim, which although it has a structural formula, does not have R_2 as a substituent. The 4-position of the thiochroman nucleus in this claim is substituted

with methyl groups. The same is true for Claim 12 and Claim 14

Claim 7 depends on Claim 6, and names a chemical compound by name. There is no R_2 in this claim.

Claim 13 depends on Claim 12, and names a chemical compound by name. There is no R_2 in this claim. Nor is there an R_2 group in Claims 15, 18 and 19 which depend on Claim 14.

In light of the foregoing, the rejection based on a purported lack of enabling disclosure with respect to the R_2 group cannot apply to Claims 4 - 7 and 12 - 19. These claims are in prima facie allowable condition.

Only Claims 1 - 3, 8, and 26 - 28 include the definition of " R_2 as lower alkyl". (Claim 9, although dependent on Claim 2, defines a specific compound where the R_2 group is methyl.)

The applicant respectfully submits, that although the examples given in the specification include compounds where the 4-position of the subject chroman and thiochroman compounds is methyl substituted, the applicant is entitled to claim a "lower alkyl" group in these compounds. This is because a methyl group is an example of a lower alkyl group, and because it is well known in the field of synthetic organic as well as pharmaceutical chemistry that lower alkyl groups, such as methyl, ethyl, propyl etc. are members of a homologous series, and that these groups tend to behave similarly from a chemical and from a pharmaceutical point of view as well. Certainly, when, as in the present specification, examples are disclosed for methyl substituted

chroman and thiochroman compounds as agents having certain useful biological activity, then one having ordinary skill in the art would readily conclude that the "ethyl", "propyl" and like "lower alkyl" homologs of the same compounds are likely to possess similar activity, and can be made by similar processes. In fact, the "equivalency" of the lower alkyl groups is one of the best known principles of structure -activity relationships in pharmaceutical and related chemistry, as is noted for example in the classic authority on the subject: Burger's Medicinal Chemistry, Fourth Edition (Edited by Manfred E. Wolff) Part 1, Chapter Eight: Guidelines for Drug and Analog Design, pages 337-338 (copy enclosed).

It is a basic principle of patent law that an applicant is entitled to claim the breadth of his or her invention, which includes structures equivalent to those which the applicant specifically provides as examples. An applicant is not limited to the specific embodiments disclosed in the examples of the specification. This principle applies fully in the present situation.

In light of the foregoing, defining R₂ as "lower alkyl" in the claims does not constitute new matter, and is supported by the original specification. Therefore, Claims 1 - 3, 8, 9, - 26 - 28 are also in prima facie allowable condition.

In summary, through the present amendment and Remarks, the applicant demonstrated that all outstanding claims of the present

application are prima facie allowable, and therefore entry of the present amendment on the record, and early allowance of the claims is respectfully solicited.

Even in the event the Examiner disagreed with allowability of some of the claims, entry of the present amendment on the record is nevertheless respectfully requested, because with regard to the majority of outstanding claims the present amendment eliminates all issues, and significantly simplifies the further prosecution of this case.

In the event the Examiner is of the opinion that a telephone conference with the undersigned attorney would materially facilitate the final disposition of this case, she is respectfully requested to telephone the undersigned attorney at the below listed telephone number.

Respectfully submitted,

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